

Appln. Serial No. 10/701,325
Reply to Office Action Mailed June 10, 2005

REMARKS

In the Office Action dated June 10, 2005, claims 22-24 were objected to; claims 1-17 and 20-25 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,959,547 (Tubel) in view of U.S. Patent No. 5,008,664 (More); and claims 18 and 19 were rejected under § 103 over Tubel and More in view of U.S. Patent No. 5,542,472 (Pringle).

Applicant acknowledges the indication that claims 22-24 and 26-27 would be allowable if rewritten in independent form.

Claims 22-24 were objected to because the use of the terms "second" and "third inductive coupler portions" was stated by the Office Action as being inconsistent with use of the terms in claims 4 and 5. Applicant respectfully submits that the terms "second" and "third" are used merely as labels to identify different inductive coupler portions. Applicant does not intend "second inductive coupler portion" and "third inductive coupler portion" in claims 22-24 to necessarily mean the same thing as the same terms in claims 4 and 5. Since claims 22-24 do not depend from claims 4 and 5, it is respectfully submitted that there is no inconsistency between claims 22-24 and claims 4-5. Therefore, it is respectfully submitted that the meaning of claims 22-24 is clear. Withdrawal of the objection is respectfully requested.

The obviousness rejection of claim 1 was maintained in the present Office Action. It is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness against claim 1, as there existed no motivation or suggestion to combine the teachings of Tubel and More to achieve the claimed invention. See M.P.E.P. § 2143 (8th ed., Rev. 2), at 2100-129.

Claim 1 recites an apparatus for use in a well having a main bore and a lateral branch, the lateral branch comprising an electrical device, and the apparatus comprising an inductive coupler mechanism to electrically communicate electrical signaling in the main bore with the electrical device in the lateral branch.

As conceded in the Office Action, Tubel fails to teach the inductive coupler mechanism as recited in claim 1. 6/10/2005 Office Action at 2. The Office Action relied upon More as teaching such an inductive coupler mechanism. *Id.* at 3. However, the Office Action has failed to establish that there existed any motivation or suggestion to combine the teachings of Tubel and More. The present Office Action cited two cases as purportedly supporting the obviousness rejection: *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); and *In re Jones*,

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958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). See 6/10/2005 Office Action at 7. It is respectfully submitted that these cases do not support the obviousness rejection. *In re Jones* holds that "[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d at 351. In *In re Jones*, the court stated that the PTO failed to cite to any objective evidence that provided the motivation to modify the teachings of the prior art references to achieve the claimed invention, and thus held that the PTO failed to establish a *prima facie* case of obviousness. *Id.* Similarly, *In re Fine* held that the PTO can satisfy the burden required to establish a *prima facie* case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d at 1074. Specifically, the court in *In re Fine* criticized the PTO's use of impermissible hindsight in reaching the obviousness rejection. *Id.* at 1075. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*

Note that More teaches use of an inductive coupler mechanism to couple components inside a main wellbore -- there is no suggestion whatsoever of using the same technique to connect between a main wellbore and a lateral branch. Although Tubel teaches electrical communication between the main wellbore and a lateral branch, it does not suggest that an inductive coupler mechanism can be used to electrically communicate electrical signaling in the main bore with the electrical device in the lateral branch. Significantly, although Tubel mentions the use of an inductive coupler, Tubel mentions the use of the inductive coupler in a side pocket mandrel depicted in Fig. 8 of Tubel. Thus, although Tubel was aware that inductive couplers were available as a technique for communicating, Tubel specifically did not suggest that such an inductive coupler can be used to communicate electrical signaling in the main bore with an electrical device in the lateral branch. This is objective evidence that a person of ordinary skill in the art prior at the time of the present invention did not contemplate the use of an inductive coupler to connect main bore electrical signaling to lateral branch devices. The only suggestion of the claimed combination is provided by the disclosure of the present application itself -- however, the obviousness rejection of claim 1 cannot be based on impermissible hindsight that

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benefits from the teachings of the present application. *See In re Fine*, 837 at 1075 ("It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.'").

Objectively, looking to the teachings of Tubel and More, a person of ordinary skill in the art would not have been motivated to combine their teachings. Electrically coupling components in a main wellbore and lateral branch is associated with challenges that are not present in coupling components within a main wellbore. Neither Tubel nor More suggests the use of an inductive coupler mechanism to address these challenges. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1 over Tubel and More.

Independent claim 2 recites a connector mechanism to connect equipment in a main bore to equipment in a lateral branch, and a first inductive coupler portion attached to the connector mechanism to communicate electrical signaling with the lateral branch equipment. As noted above, there is no motivation to combine Tubel and More to achieve the recited subject matter. Furthermore, even if Tubel and More can be properly combined, there is no teaching or suggestion by the hypothetical combination of Tubel and More of a first inductive coupler portion *attached to the connector mechanism* to communicate electrical signaling with the lateral branch equipment.

In response to the arguments presented above, the present Office Action stated that this argument "is not at all persuasive" and that "[e]verything in the wells shown by Tubel and More are 'attached'; thus one of ordinary skill in the art would know to make any modification 'attached': to do otherwise would result in the components being swept along the flow, lost, or damaged." 6/10/2005 Office Action at 7.

Applicant respectfully disagrees with this assessment. Claim 2 specifically states that the first inductive coupler portion is attached to the connector mechanism, which is used to connect equipment in the main bore to equipment in the lateral branch. There is no teaching or suggestion in either Tubel or More of attaching an inductive coupler portion to the connector mechanism. Note that Tubel teaches providing an inductive coupler portion in a side pocket mandrel (see Fig. 8 of Tubel). More teaches attaching inductive coupler portions at a wellhead and also to downhole tubing in the main bore – More does not teach attaching an inductive

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coupler portion to a connector mechanism as recited in claim 2. Thus, although Applicant agrees with the Examiner that an inductive coupler portion would typically be attached to some structure in a well, there is no teaching or suggestion in either Tubel or More of attaching an inductive coupler portion to a connector mechanism adapted to connect equipment in the main bore to equipment in the lateral branch.

Therefore, a *prima facie* case of obviousness has not been established with respect to claim 2. Dependent claims of claim 2 are allowable for at least the same reasons.

With respect to independent claim 8, there is no motivation or suggestion to combine the teachings of Tubel and More to achieve a completion string that includes equipment in the main bore and in the lateral branch, a first inductive coupler assembly proximal the equipment in the main bore, and a second inductive coupler assembly proximal the equipment in the lateral branch, and an electrical cable connecting the first and second inductive coupler assemblies. Tubel fails to teach or suggest first and second inductive coupler assemblies, and More fails to teach or suggest the second inductive coupler assembly proximal equipment in the lateral branch. No suggestion existed in either of the references to combine their teachings to achieve the claimed invention. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 8.

Claims dependent from claim 8 are allowable for at least the same reasons.

Independent claim 20 is also allowable over the asserted combination of Tubel and More, since no motivation or suggestion existed to combine the teachings of Tubel and More to achieve the provision of a first inductive coupler assembly electrically connected to main bore equipment and in communication with lateral branch equipment. A *prima facie* case of obviousness has therefore not been established with respect to claim 20.

Claims dependent from claim 20 are allowable for at least the same reasons. Moreover, with respect to dependent claim 25, which depends indirectly from claim 20, there is no teaching or suggestion in Tubel and More of providing a connector to connect the main bore equipment to the lateral branch equipment, where the connector has a receptacle to receive the main bore equipment, and the connector has a portion of the first inductive coupler assembly.

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In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0152D1US).

Respectfully submitted,

Date: _____

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